Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

RE: TRADEMARK APPLICATION OF BULL, S.A.
Serial No. 74-061,190 [FN1]
June 13, 1991
***1** Request Filed: January 23, 1991

For: OPENPACK
Filed: May 21, 1990 [FN2]

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On Request for Reconsideration

Bull, S.A. has requested the Commissioner to reconsider the decision of January 7, 1991, which denied petitioner's claim of a May 21, 1990 filing date for the above-referenced application.

FACTS

Petitioner's application was initially submitted on March 5, 1990. It was returned to petitioner under cover of a May 11, 1990, Notice of Incomplete Trademark Application from the Supervisor of the Application Section. Specifically, the application was rejected as one based on Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), but one which did not contain the required statement of applicant's bona fide intention to make use of the mark in commerce.

On May 21, 1990, a petition to the Commissioner was filed. The petition disputed the characterization of the application as incomplete and asserted that the application complied with relevant statutory requirements. Though the petition was forwarded to the Office of the Assistant Commissioner for Trademarks for review, the application itself was detached, sent to the Application Section and rejected a second time as incomplete; this second Notice of Incomplete Trademark Application was issued on July 9, 1990. [The resubmission of the application with the May 21st petition, its detachment, and its second rejection, are facts that were not established until submission of the instant request for reconsideration.]

A second application, submitted concurrently with the May 21st petition, was rejected by the Application Section as a late-filed

Section 44(d) application. The Notice of Incomplete Trademark Application was issued by the Supervisor of the Application Section on July 18, 1990. A second petition was filed on August 3, 1990 requesting that the second application be accepted for filing. This petition asserted that the Application Section acted in error when it construed the second application as a late-filed Section 44(d) filing. Petitioner asserted that it was filed as an "intent to use" application pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Petitioner clearly filed two distinct petitions, each in search of a filing date for a particular application. However, the application that was the subject of the first petition and its attached application were separated by mail room personnel and the application was eventually returned to petitioner. This particular application was not resubmitted until the filing of the instant request for reconsideration. Thus, when the challenged petition decision was being drafted, there were two petitions presenting distinct issues, but only one application, which were subject to review. As a result, the two petitions were consolidated and treated as one. The arguments raised in both petitions were addressed in one decision. The challenged decision upheld the rejections of both of petitioner's applications.

DECISION

***2** In the request for reconsideration, petitioner has stated that it does not seek further review of the sufficiency of the first application, either in the context of its initial submission on March 5, 1990, or its resubmission under cover of the first petition on May 21, 1990. Petitioner only seeks review of that portion of the Commissioner's decision which concluded that the second application was properly rejected.

1. Contents of the Second Application

Petitioner's second application, as noted above, was rejected by the Application Section as an attempt to file pursuant to Section 44(d) more than six months after the filing of the corresponding foreign application. The second application included the following distinct, one-sentence "paragraphs":

"Application to register said trademark in France was filed on October 11, 1989, Application No. 160 274.

The applicant has a bona fide intention to use the mark in commerce for the goods and services.

The mark is intended to be used on the goods and on literature for the services.

Certificate of such registration will be presented upon issue."

2. Petitioner's Arguments on Reconsideration

As noted in the decision which petitioner challenges, petitioner's second application failed to specify any particular basis for filing.

Since the basis for the application was not explicitly stated, the Supervisor of the Application Section was called upon to determine the apparent or probable basis for the application. The challenged petition decision determined that no error was committed when the Supervisor concluded that the application constituted an untimely attempt to file under Section 44(d). Petitioner contends the Supervisor's conclusion was erroneous and asserts that the challenged petition decision which found no error in that conclusion (1) misapplied prior decisions regarding the sufficiency of particular applications, and (2) failed to properly construe the substance of petitioner's application by placing undue emphasis on its form, rather than its substance.

A. TMEP 1003.02 and Interpretation of In re Choay

Petitioner argues that the reference to its filing of an application in France was set forth "for informational purposes" only. Petitioner further asserts that "there can be no question that no claim of foreign priority was being made in the ... application." Since Trademark Rule 2.21, 37 C.F.R. § 2.21, requires the setting forth of "a claim of the benefit of a prior foreign application" in any application filed pursuant to Section 44(d), and petitioner's application included no such claim, petitioner concludes that the only reasonable presumption is that it did not intend to file pursuant to Section 44(d). The argument ignores long standing Office policy set forth in Section 1003.02 of the Trademark Manual of Examining Procedure (TMEP) and applied in the decision of In re Trademark Application of Choay S.A., 16 U.S.P.Q.2d 1461 (Comm'r Pats.1990).

***3** When petitioner's first application and second application are compared, it is revealed that the first filing contained a specific "claim" of priority that was deleted from the second filing. However, Office policy does not rigidly require Section 44(d) applicants to literally "claim" the benefit of a foreign application. Rather, TMEP Section 1003.02, as cited in Choay, provides that "the inclusion of a statement that an application has been filed in a particular country on a specified date will be taken to establish a 'claim' or 'statement' of priority when the record shows that filing in the United States was effected within six months of the foreign filing." In re Choay, 16 U.S.P.Q.2d at 1463 (emphasis added). Thus, while petitioner clearly deleted its "claim" of priority before refiling its application, the "informational" material regarding its French filing that remained in the application is sufficient under Office practice to stand as a "statement" of priority. Further, the deletion of the claim of priority was neither noted for, nor apparent to, the Supervisor of the Application Section, who was called upon to review the second application on its own merits.

Petitioner construes the above quoted passage from Choay, which outlines the practice of accepting foreign filing information as a statement of priority, as a practice followed only when filing of an application with a "statement" of priority is effected within six months. Since its application was not filed in the relevant priority filing period, petitioner argues that the conclusion must be that no statement of priority was "being made" in accordance with this practice. The argument is strained, and the conclusion drawn by the

Application Section that a statement of priority was "made" but was simply not validly "established" by the application because of the lateness of filing was entirely appropriate.

The practice outlined in the TMEP and in Choay is intended to benefit those Section 44(d) applicants who fail to follow the literal requirements of Rule 2.21 and therefore fail to specifically "claim" priority. The fact that the Office will consider language such as that used by petitioner in its second application as a "statement" of priority was clearly disclosed in the TMEP and Choay. While it is unfortunate that petitioner has unwittingly been caught in a safety net intended to help applicants, petitioner must bear the risks associated with its inclusion of "information" unnecessary to the asserted basis of its application.

B. Interpretation of In re Miguez

Petitioner also asserts that the challenged petition decision fails to take account of petitioner's inclusion of a statement regarding the "intended method of use" of the mark and misapplies the earlier decision of In re Trademark Application of Miquez, 16 U.S.P.Q.2d 1458 (Comm'r Pats.1990). This argument must be rejected.

***4** In Miguez, the Supervisor of the Application was held not to have erred when she refused to accord an application a basis for filing under Section 1(b). In that case, the application did not explicitly refer to Section 1(b) or claim filing pursuant to the "intent to use" provisions of the Trademark Act. The applicant in Miguez did, however, obtain a filing date under Section 1(b) on petition to the Commissioner. The applicant prevailed on petition because it was shown that the application in issue included two distinct paragraphs. The first paragraph included an intent to use statement and an intended method of use statement. The second paragraph included another intent to use statement, referred to the contemporaneous submission of a foreign certificate, and referenced Section 44 of the Trademark Act. It was held that the first of the two paragraphs established the Section 1(b) basis.

The instant petitioner argues that its intent to file pursuant to Section 1(b) is as readily apparent as was the intent of the applicant in Miguez. Specifically, petitioner notes that its application "sets forth in separate paragraphs" its intent to use statement and its intended method of use statement. The instant case is, in fact, a good deal different from Miguez. In that case, the application included two distinct paragraphs. The instant case sandwiches an intent to use statement and a statement of the intended method of use between two statements relative only to Section 44 filings. While petitioner may argue that the statement regarding its foreign filing was provided for informational purposes, the statement setting forth petitioner's promise to file a certified copy of its foreign registration when it issues is neither informational nor relevant to a Section 1(b) filing. Its inclusion in the application makes sense only when considered in conjunction with the statement regarding petitioner's foreign application.

The decision of Miguez relied, in part, on the petitioner's inclusion of a statement of the "intended method of use," which is required in Section 1(b) applications but is not required in Section 44 applications. In this case, petitioner included such a statement in its application and now argues that this stands as further evidence of its intent to file pursuant to Section 1(b) rather than pursuant to Section 44(d). While the statement is not required in Section 44 applications, it is not unusual to find statements regarding the method of use or intended method of use in such applications. Often such statements are "boilerplate" statements included in the word processors of applicants and attorneys who file a great many applications with the Office. Its presence in petitioner's application cannot establish filing pursuant to Section 1(b) when so many other factors point to a contrary conclusion.

C. Form vs. Substance

Petitioner's second argument asserts that, though its application may not be in a preferred form, the substance of the application is acceptable and it would be unjust not to accord the application a filing date. Petitioner is not being "penalized" through an unjust elevation of form over substance. Petitioner simply filed an application that is totally silent as to the basis and left the Office to determine its substance. Based on the form of the application, the Supervisor of the Application Section determined that its substance was that of a Section 44 application.

***5** Trademark Rule 2.21, specifies the elements that must be received if an application is to receive a filing date. Subsection (a)(5) of the rule requires that each application must include a "basis for filing." The argument can be made that any application which is filed pursuant to Trademark Act Section 44(d), and therefore includes an "intent to use" statement, necessarily complies with the only substantive requirement of Rule 2.21 for setting forth the basis of an "intent to use" application. [FN3] Under this theory, any application which is timely filed pursuant to Section 44(d) should also be considered as filed under Section 1(b). Further, this theory would also allow a late-filed Section 44(d) application to be accepted as a Section 1(b) application.

The Office has clearly rejected such an approach. In Examination Guide 3-89, distributed as a supplement to the Trademark Manual of Examining Procedure, and published in the Official Gazette at 1108 TMOG 30, it is stated: "The Office will not presume that an application under Section 44 is also based on intent to use under Trademark Act Section 1(b).... If the applicant indicates that Section 44 is the basis, and nothing more, and the applicant fails to comply with the relevant Section 44 filing-date requirements, the applicant will be denied a filing date, even if the application includes a statement of a bona fide intention to use the mark in commerce."

Accordingly, if petitioner's argument that it has complied with the substantive requirements necessary to obtain a filing date under "intent to use" is based on the theory that its application, even if considered to be a defective Section 44 filing, includes an "intent to

use" statement (i.e., the only substantive requirement of a Section 1(b) application), then the argument must be rejected.

3. The Application Remains Unacceptable for Filing

The decision denying petitioner a filing date of May 21, 1990 will not be reversed. Nonetheless, the question must be addressed as to whether the application may be accorded a filing date of either August 3, 1990, the filing date of the second petition, or January 23, 1991, the date of the filing of the instant request.

With its request for reconsideration, petitioner submitted a copy of its first application. There is no question that this application was properly rejected by the Application Section, and petitioner does not, now, question that action. Instead, petitioner's arguments are directed to its contention that its second application ought to have been construed as, and accepted as, a Section 1(b) filing. Viewed on its own, the second application does not "look like" an intent to use application. However, when compared with the first application, it is apparent that the second was "intended" to be filed as a Section 1(b) application, notwithstanding petitioner'sfailure to make this intention known through inclusion of a simple reference to filing under that provision of the Act.

***6** A comparison of the first and second applications reveals: (1) the first application did not include an intent to use statement, while the second application did; (2) the first application included a reference to petitioner's foreign application and noted "applicant claims a right of priority thereof under the International Convention," while the second application was devoid of the quoted language; (3) the first application did not include a statement of the intended method of use, while the second application did.

Though petitioner explicitly stated, in its petition of August 3, 1990, that the second application was based on Section 1(b) of the statute, and despite the fact that a comparison of the first and second applications supports this contention, the application remains unacceptable for filing. Office policy governing review of applications for compliance with statutory filing requirements dictates that the application form itself contain all appropriate elements. [FN4] Elements such as the identification of the applicant, the identification of goods, and the basis for filing cannot be supplied in separate documents, such as the drawing sheet or transmittal letter. The compliance of each application with filing date requirements must be determined is judged by the contents within the four corners of the application.

In this case, petitioner cannot rely on the fact that its August 3, 1990 petition contains an explicit statement as to the basis of the second application. Nor can petitioner rely on the fact that a comparison of the two applications arguably reveals the "intended" basis for the second application. The substance of the second application, according to clear Office policy, is that of a Section 44(d) application. Since its submission was not timely enough to allow for filing under that provision of the statute, the application must be

rejected.

CONCLUSION

The request for reconsideration is denied. The application materials submitted with the petition and request for reconsideration are returned with this decision.

FN1. This serial number has been declared misassigned and will not be reassigned to the application in issue in this case.

FN2. The issue presented by the instant petition is whether the second of two applications filed by petitioner is entitled to this date, or any other date, as a filing date.

FN3. This argument applies equally to Section 44(e) filings.

FN4. Of course, this does not include drawing sheets, fee checks, or the specimens necessary for use applications which, by their very nature, must be separate items.

20 U.S.P.Q.2d 1703

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